

REMARKS

In the aforementioned claim amendments, claims 1, 2, 4, 5, 6 and 9 are amended. Now pending in the application are claims 1-10, of which claims 1 and 9 are independent. The following comments address all stated grounds for rejection and place the presently pending claims, as identified above, in condition for allowance.

Objections to Drawings

The drawings are objected to because of reference sign “6” in Figure 7. In response to the objections, Applicant amends Figure 7 to change reference sign “6” to reference sign “5”. In light of the amendment to the drawings, Applicant submits that the drawing are in condition for allowance.

Objections to Claims

Claims 1, 2, 4 and 6-9 are objected to because of some informalities. In response to the objections, Applicant amends claims 1, 2, 4 and 6-9 to cure the informalities as suggested by the Examiner in the Office Action. For example, Applicant amends claim 1 to change the first occurrence of “the eye-contacting surface” in line 4 to “an eye-contacting surface”. In light of the amendment to the claims, Applicant submits that claims 1, 2, 4 and 6-9 are in condition for allowance.

Claim Rejections under 35 U.S.C. § 112

Claims 4-6, 9 and 10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner notes that it is unclear whether each ring of the series has a perimeter consistent with that of the probe head in claim 4. In response to the rejection,

Applicant amends claim 4 to clarify that each ring of the series has a perimeter consistent with that of the probe head.

The Examiner also notes that it is unclear which backing sheet is being referred to in claim 5. In response to the rejection, Applicant amends claim 5 to clarify that the first backing sheet is being referred to.

The Examiner further notes that it is unclear whether the pieces or the probe head has at least one sterile surface in claim 9. In response to the rejection, Applicant amends claim 9 to clarify that the pieces have at least one sterile surface.

The Examiner notes that it is unclear how many surfaces each piece has, and if each piece were to have a plurality of surfaces, what surface would be in opposition to the sterile surface. In response to the rejection, Applicant amends claim 9 to clarify that the surface of each piece of substantially transparent material is opposing the sterile surface.

Applicant believes that the aforementioned claim amendments address all of the rejections raised by the Examiner in the Office Action under 35 U.S.C. § 112, second paragraph. In light of the aforementioned claim amendments, Applicant requests the Examiner withdraw the rejections of claims 4-6, 9 and 10 under 35 U.S.C. § 112, second paragraph, and pass the claims to allowance.

Claim Rejections under 35 U.S.C. § 103

Claims 1-7, 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,002,057 to Brady ("Brady") in view of U.S. Patent No. 5,935,058 to Makita *et al.* ("Makita"). Applicant respectfully traverses this rejection in light of the following reasons.

Claim 1 recites a pack of barriers for use in relation to an eye contacting optical testing apparatus. The pack of barrier comprises a first backing sheet on which are removably attached *a plurality of barriers* of substantially transparent film each having dimensions comparable to those of the eye-contacting surface of a head of a probe of the optical testing apparatus. The surface of the substantially transparent film adjacent the first backing sheet is sterile and the alternative surface of the substantially transparent film is provided with *a peelable adhesive*. The pack of barrier comprises a second backing sheet to which the plurality of barriers and the first backing sheet are adhered by the peelable adhesive. Claim 9 also recite *a plurality of barriers*.

Applicant respectfully submits that Brady and Mikita fail to teach or suggest all of the limitations of the claimed invention. Applicant submits that Brady fails to teach or suggest *a plurality of barriers* in which the surface adjacent the first backing sheet is sterile and the alternative surface is provided with a *peelable adhesive*, as recited in claim 1. Brady teaches in Fig. 2 a removable holder (30) for maintaining the sterility of the barrier 22 while handling the barrier. Brady teaches a carrier strip (32) and a sealed envelope structure (34) for holding the barrier (22). Applicant submits that it is apparent that Brady does not teach *a plurality of barriers in which* the alternative surface is provided with a *peelable adhesive*.

Furthermore, Brady teaches away from the claimed invention. Brady teaches that the side portion (26) of the conformable barrier (22) is constructed to resiliently cling without the aid of an adhesive (See, column 2, lines 28-33). Brady teaches not using an adhesive on the surface of the barrier on the side of the sealed envelope structure (the second backing sheet). In contrast, the claimed invention recites that the alternative surface of the barriers on the side of the second sheet is provided with a *peelable adhesive*. Accordingly, Brady teaches away from the claimed invention.

The examiner recognizes that Brady fails to teach a plurality of covers to provide a pack of barriers. Makita is cited to compensate for this deficiency. Applicant submits that Makita also fails to teach or suggest *a plurality of barriers* in which the surface

adjacent the first backing sheet is sterile and the alternative surface is provided with a *peelable adhesive*, as recited in claim 1. Makita teaches in FIG. 6 a chain of interconnected covers (30) consisting of a plurality of the probe covers (20) linked successively into the form of a strip. Makita also teaches that the chain of interconnected covers (30) are supplied in a form wound upon a cylindrical core. Makita does not teach that one side of the chain (30) is sterile and the other side is provided with a peelable adhesive. In light of the aforementioned argument, Applicant submits that Brady and Makita fail to teach or suggest all of the limitations of the claimed invention.

Additionally, Applicant respectfully submits that there is no motivation to combine the reference teachings. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide a plurality of sterile probe covers similar to those of Brady on a perforated sheet in view of the teachings of Makita for simplifies manufacturing convenience dispensing and easy detachment of single covers as desired without requiring use of cutting tool. Applicant respectfully disagrees.

Applicant respectfully submits that there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of these references because the device taught in Brady is not suitable for a plurality of barriers taught in Makita. The device in Brady cannot be used with the plurality of covers taught in Makita because structure of the device in Brady would be more complicated to use the plurality of covers taught in Makita. Furthermore, Brady teaches that the carrier strip (32) includes a perforation (42) to remove the carrier strip (32) upon mounting in place the conformable barrier (22) to the prism (12). This means that the device in Brady is intended to use with a single barrier, not a plurality of barriers in a single sheet. In light of the aforementioned arguments, Appellant respectfully submits that there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings.

Based on the arguments set forth above, Applicant submits that the Examiner fails to establish a prima facie case of obviousness to reject claims 1-7, 9 and 10 under 35 U.S.C. § 103(a). Applicant therefore respectfully requests the Examiner withdraw the rejection of claims 1-7, 9 and 10 under 35 U.S.C. § 103(a), and pass the claims to issuance.

Claim Rejections under 35 U.S.C. § 103

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Brady in view of Makita, and further in view of U.S. Patent No. 4,922,914 to Segal *et al.* ("Segal"). Applicant respectfully traverses this rejection in light of the following reasons.

Claim 8 depends from claim 1. Claim 8 incorporates the patentable features of claim 1 and adds a separate patentable feature, such as the tabs provided with an adhesive substance for retaining the barrier onto the head of the probe.

Applicant submits that Segal also fails to teach or suggest *a plurality of barriers* in which the surface adjacent the first backing sheet is sterile and the alternative surface is provided with a *peelable adhesive*, as recited in claim 1. Segal teaches a disposable cover (100) for tonometer. However, Segal does not teach *a plurality of barriers in which* the alternative surface is provided with a *peelable adhesive*.

In light of the aforementioned argument, Applicant respectfully submits that the cited references fail to teach or suggest all of the limitations of claim 8. Applicant therefore submits that claim 8 is in condition for allowance.

CONCLUSION

For the foregoing reasons, Applicant contends that Claims 1-10 are in condition for allowance. If there are any remaining issues, an opportunity for an interview is requested prior to the issuance of another Office Action. If the above amendments are not deemed to place this case in condition for allowance, the Examiner is urged to call Applicant's representative at the telephone number listed below.

Respectfully submitted,
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